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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,774

05/26/2006

Andreas Mayer-Gindner

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ALEXANDRIA, VA 22314

EXAMINER

CRANDALL, LYNSEY P

ART UNIT

PAPER NUMBER

3769

MAIL DATE

DELIVERY MODE

05/10/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/524,774	<b>Applicant(s)</b> MAYER-GINDNER ET AL.	
	<b>Examiner</b> LYNSEY CRANDALL	<b>Art Unit</b> 3769	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/16/2005</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 4 is objected to because it includes a reference character that is not enclosed within parentheses.
2. Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m). Specifically, “first transition piece 11” should be “first transition piece (11)”.
3. Claim 3 is objected to because the two channel shaped half shells (11.2, 11.2) are referred to as element (11.1) in the detailed description of the drawings.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 3 recites the limitation “wedge-shaped ridges in transverse direction”. It is unclear to the examiner what a transverse direction means, specifically transverse to what?
6. Claim 1 recites the limitation “the end area” in line 3. There is insufficient antecedent basis for this limitation in the claim.

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7. Claim 1 recites the limitation "the transition piece" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim. Examiner assumes this should read "the first transition piece".
8. Claim 1 recites the limitation "the outlet" in line 5. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 3 recites the limitation "the transition piece" in line 1. There is insufficient antecedent basis for this limitation in the claim. Examiner assumes this should read "the first transition piece".
10. Claim 3 recites the limitation "the jacket" in line 3. There is insufficient antecedent basis for this limitation in the claim.
11. Claim 4 recites the limitation "the end area" in line 1. There is insufficient antecedent basis for this limitation in the claim.
12. Claim 5 recites the limitation "the end area" in line 4. There is insufficient antecedent basis for this limitation in the claim.
13. Claim 5 recites the limitation "the focusing region" in line 5. There is insufficient antecedent basis for this limitation in the claim.
14. Claim 5 recites the limitation "the entrance opening" in line 6. There is insufficient antecedent basis for this limitation in the claim.
15. Claim 6 recites the limitation "the hollow cylindrical end portion" in line 2. There is insufficient antecedent basis for this limitation in the claim.
16. Claim 6 recites the limitation "the end portion" in line 2. There is insufficient antecedent basis for this limitation in the claim.

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17. Claim 7 recites the limitation "the cone-shaped inner surface" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

18. Claim 8 recites the limitation "the end portion" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

19. Claim 8 recites the limitation "the coated optical wave guide" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,358,272 to Wilden.

22. [Claim 1] Wilden discloses a transmission device for introducing optical radiation into the ear (Fig. 3a), comprising an optical wave guide (311) which connects a light source (310) to an ear holder (311a and 321) to output said radiation, characterized in that the ear holder comprising a first transition piece (311a), wherein the end area of the optical waveguide (312) is maintained, and a retaining bar (321) which can be introduced into the transition piece and can be bent in such a manner that the outlet of the optical waveguide can be positioned on the ear. Wilden discloses that the device is

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made of a material which permits the therapist fitting the apparatus to adjust the position of the light exit by bending or swiveling it, or the like (Col 5, lines 1-5).

23. [Claim 2] As seen in Fig. 3a, the first transition piece (311a) is bent with respect to the rest of the device (320); this bend is interpreted as elbow-shaped.

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,358,272 to Wilden as applied to claim 1 above, and further in view of US 5,293,877 to O'Hara et al.

26. Wilden is discussed above, but is silent with regards to a replaceable ear piece that is inserted into the ear. O'Hara discloses a medical device that is inserted into the ear that includes a disposable/replaceable sanitary cover (23, Fig. 1A) that is mounted over the tip (14a) of the probe prior to inserting the probe into a patient's ear canal (Col , lines ). It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to include a disposable/replaceable sanitary cover as taught by O'Hara in the ear treatment device taught by Wilden in order to provide a sanitary device when treating multiple patients.

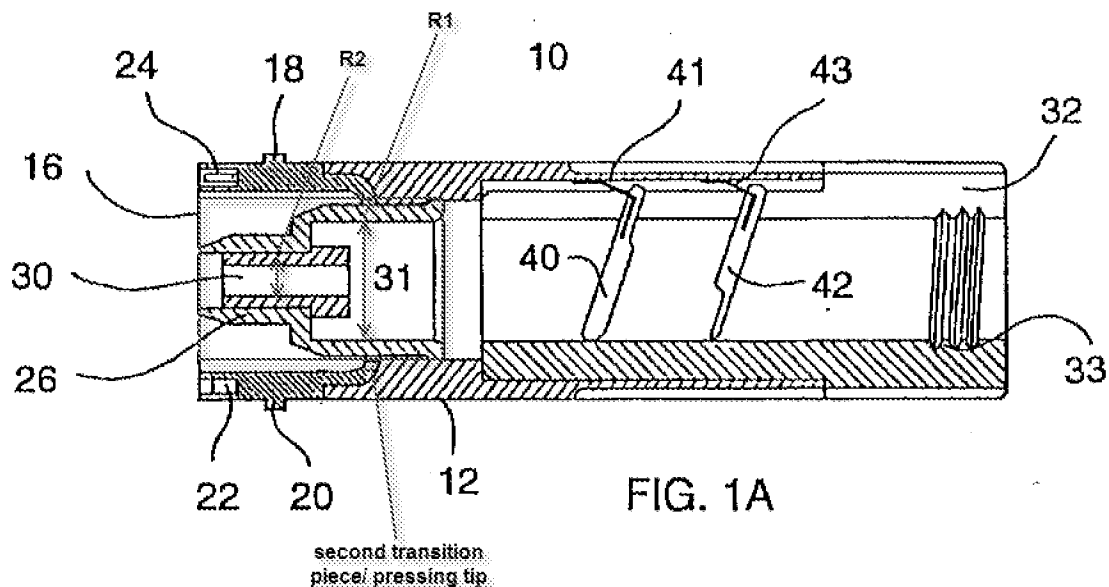
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27. Claims 5, 6 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,358,272 to Wilden as applied to claim 1 above, and further in view of US 5,570,445 to Chou et al.

28. [Claims 5, 6 and 8] Wilden is discussed above, but is silent with regards to a second transition piece for introducing laser radiation into the optical waveguide. Chou discloses a connector adapter for coupling a laser source to an optical fiber (abstract). The second transition piece is labeled below. Chou discloses that this piece is generally conical shaped (Col 7, lines 6-48); this is interpreted as a conical tapered inner surface shaped in the form of a hollow cylinder, as seen below. The pressing tip accommodates the end of the optical waveguide (28, Fig. 1C) and comprises a through bore (30 and 31) having a radius R1 and R2 (labeled below). The limitations “wherein the focusing region generated in the focusing sleeve of the laser radiation is immediately ahead of the entrance opening of the optical waveguide” (Claim 5), “into which the end portion of the coated optical waveguide is inserted, in particular glued” (Claim 8), and “into which a de-coated end portion of the optical waveguide is protruding with its entire length” (Claim 8) are interpreted as intended use. Intended use/functional language does not require that the reference specifically teach the intended use of the element. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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29. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to include this connector adapter taught by Chou in the device taught by Wilden in order to safely and efficiently transmit laser energy from the laser source to the optical fiber as taught by Chou (abstract).



30.

31. [Claims 9-11] Chou discloses two holders (22 and 24, Fig. 1A) and coupling portions (18 and 20, Fig. 1A) for detachably connecting the second transition piece and the laser source (Col 6, lines 25-54). As Chou teaches a cylindrical device, these holders (22 and 24) are considered to be disposed along a ring.

32. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,358,272 to Wilden as applied to claim 1 above, and further in view of US 4,519,390 to Horne.

33. Wilden is discussed above, but is silent with regards to a metal connector piece. Horne discloses that conventional connectors for interconnecting the optical fiber with a laser source incorporate a convex gold collar disposed about the end of the optical fiber



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(Col 1, lines 48-60). This convex gold collar is interpreted as having a conical tapered inner shape in the form of a hollow cylinder.

34. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,358,272 to Wilden as applied to claim 2 above, and further in view of US 4,354,065 to Buettner.

35. Wilden is discussed above, but is silent with regards to a specific construction of the ear piece. Buettner discloses a hearing aid worn about the ear that includes two half shells (2 and 3, Figs. 1 and 2) with projections, interpreted as wedge-shaped ridges, that hold the parts inside of the device in place (Col 1, lines 42-50). It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to use the shells taught by Buettner in the device taught Wilden as it is commonly known way to manufacture small ear piece devices in order to hold the inner pieces of the device in place as taught by Buettner. Furthermore, the "wedge-shaped ridges in transverse direction" is considered a design choice, as applicant has not given any criticality to the shape or direction of these ridges.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LYNSEY CRANDALL whose telephone number is (571)270-7035. The examiner can normally be reached on Monday to Thursday 8:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hank Johnson can be reached on (571)272-4768. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LYNSEY CRANDALL/  
Examiner, Art Unit 3769

/Henry M. Johnson, III/  
Supervisory Patent Examiner, Art  
Unit 3769

5/6/2010